

REMARKS

This application has been amended in a manner that is believed to place it in condition for allowance at the time of the next Official Action.

Claims 14-25 are pending. It is now specified that the step of separating/fractionating is carried out in an industrial starch unit for the treatment of potato. Basis for this amendment can be found at page 16, lines 19-22 of the specification. The specification has also been amended to correct several informalities.

Claims 14-24 are rejected under 35 USC §112, first paragraph, for allegedly not satisfying the written description requirements. This rejection is respectfully traversed.

The recitation '*configuration used in a potato starch factory*' has been deleted from the wording of the claims. It is hence respectfully submitted that the corresponding rejections under 35USC112 should be withdrawn.

Claims 14-24 were rejected under 35 USC §102 as allegedly being anticipated by Nickel (US patent 5,034,227). This rejection is respectfully traversed.

The claims recite that that the step of separating/fractionating is carried out in an industrial starch unit for the treatment of potato.

Nickel may refer to some pieces of equipments (e.g. cyclones or centrifuges), but remains silent as to any possible industrial plant or factory wherein the process is to be performed. As a result, applicants believe that Nickel fails to anticipate the claimed invention.

Applicants also submit herewith a Declaration Under Rule 312 providing further evidence as to how the present invention is distinguishable from Nickel.

Moreover, at this time, the Examiner is respectfully reminded that to establish a *prima facie* case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the publications themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a publication. Second, there must be a reasonable expectation of success. Third, the publications must teach or suggest all the claim recitations.

The teaching or suggestion to make the claimed invention and the reasonable expectation of success must be found in the publications, and not based on applicant's disclosure. *In re Vaeck*, 947 F2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also MPEP §2143-2143.03. Upon reviewing the outstanding Official Action, it is believed that the Official Action fails to satisfy these criteria.

As Nickel is silent as to any possible industrial plant or factory wherein the process is performed, applicants believe that one skilled in the art would lack the motivation to modify the publication in a manner so as to obtain the claimed invention.

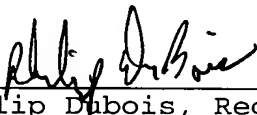
Applicant thus respectfully submit that the subject-matter of the pending claims is neither anticipated, nor rendered obvious by the above-identified publication.

In view of the above, it is respectfully submitted that the application is now in proper form for allowance.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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APPENDIX:

The Appendix includes the following item(s):

Declaration Under Rule 312